

Appln No. 09/882,351

Amdt date March 1, 2004

Reply to Office action of October 1, 2003

REMARKS/ARGUMENTS

Claims 1, 2 4, 7 to 14, and 17 to 23 are pending in this application. Applicant has canceled claims 3, 5 and 15 with the limitations of claims 3 and 5 being added to independent claims 1 and 14, respectively, along with additional amendments. Claims 4 and 23 have been amended to correct their dependency. The amendments find full support in the original specification and claims. No new matter is presented.

In view of the amendments set forth above by which applicant has amended independent claims 1 and 14 to include the limitations of dependent claims 3 and 15, respectively, the examiner's rejections under Section 102 is now moot. Therefore, applicant will focus the remarks to the rejection of claims 3 and 15.

In the Advisory Action dated January 26, 2004, the examiner maintained her rejection of claim 3 as allegedly unpatentable over Rourke in view of Walker, Jr. et al., and her rejection of claim 15 as allegedly unpatentable over Rourke in view of Takahashi et al., and further in view of Walker, Jr. et al. In an interview with the examiner on February 26, 2004, applicant's attorney pointed out that while Walker et al. may disclose that "polyethylene oxide is functionally equivalent to polypyrrole, polyaniline, polyacetylene, or polyalkylthiophene for preparing a *solid electrolyte*," (April 17, 2003 Office action, page 4., emphasis added), because Walker, Jr. et al. teach the use of such materials in producing a *solid electrolyte* rather than in preparing a *positive active material*, one of ordinary skill in the art would not look to Walker et al for substitutions for the coating materials taught by Rourke. In response, the examiner pointed out that in the background section of Rourke, composite cathode constructions are disclosed which are made by coating an electrode material with a polymeric electrolyte. (Rourke, column 1, lines 15-19.) According to the examiner, Rourke provides the suggestion to look to a reference such as Walker, Jr. et al. for the inventive coatings.

However, upon reviewing the examiner's argument in further detail, there is an important distinction between on the one hand, the teachings of the present invention and the primary disclosure of Rourke, and on the other hand, the disclosure in the background section of Rourke. The background section of Rourke teaches that an electrode is first formed, and then coated. In

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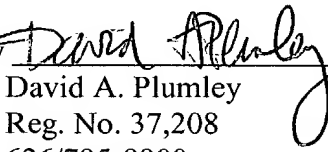
contrast, the claimed invention discloses that a plurality of particles are encapsulated prior to being formed into an electrode. Similar to the present invention, and in contrast to the background section of Rourke, the primary disclosure of Rourke also teaches the coating of particles rather than the coating of already formed electrodes. Consequently, applicant maintains that one of ordinary skill in the art *would not* look to the background section of Rourke to find coating materials for metal oxide *particles* which can then be formed into a cathode. The polymers are being provided for two very different purposes and there is no motivation to combine the cited references to arrive at the claimed invention.

While original claims 3 and 15 already recited that the coating solution is applied to "metal oxide *particles*" to "encapsulate the *particles*," applicant has amended independent claims 1 and 14 to specifically recite that the claimed method is: "A method of preparing *a plurality of encapsulated particles for use as a* positive active material for a lithium secondary battery." (Emphasis added.) Consequently, claims 1 and 14, as amended, are allowable over the art of record, as are dependent claims 2 4, 7 to 13, and 17 to 23

In view of the amendments and remarks set forth above, Applicant submits that claims 1, 2 4, 7, to 14, and 17 to 23 are in condition for allowance. However, if there are any remaining issues that can be addressed by telephone, applicant invites the examiner to contact counsel at the number below.

Respectfully submitted,

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